

No. 2456

IN THE
United States Circuit Court of Appeals
NINTH CIRCUIT

**CHARLES EDWARD GRELLE AND
THE INDEPENDENT FOUNDRY COMPANY,
a Corporation,
APPELLANTS**

vs.

**CITY OF EUGENE, OREGON,
AND M. F. GRIGGS
APPELLEES**

Appeal from the District Court of the United States
for the District of Oregon

Brief of Appellees

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STATEMENT OF FACTS.

On the 2nd day of January, 1912, Charles Edward Grelle filed in the office of the Commissioner of Patents of the United States an application for letters patent to him on an ornamental lamp post which the said Grelle claims to have designed, a cut of which post will be found on page fifteen of appellant's transcript of record, and appellants' Exhibit "A" in the trial.

On March 12th, 1912, patent was issued to said Grelle covering said post. The patent was intro-

duced in evidence and marked "Plaintiffs' Exhibit S," and the post is afterwards referred to in said trial as Type "S" post.

The City of Eugene is a municipal corporation of twelve thousand inhabitants. The city owns and operates its own electric light plant for the purpose of lighting the streets, alleys and public parks of the city, and selling electricity to the inhabitants thereof. The operation of the electric lighting plant is under the immediate control of the Eugene Water Board, a body created and existing under the charter and ordinances of the city. The city, through its water board planned to light the principal streets of the city by means of light posts, doing away with the old arc light system, and to that end the water board asked for bids from various concerns for furnishing light posts to the city. Charles Edward Grelle was at that time, and at the time of the trial of this cause, president and manager of the Independent Foundry Company. The Independent Foundry Company had the exclusive right and license to make and sell the type "S" post designed by Mr. Grelle.

Alvin Meyers, who was then the superintendent of the water board of the city, at the instance of the water board, designed a lamp post and submitted the same to the water board. The water board accepted the design of Mr. Meyers and called for bids for manufacturing the same. The Independent Foundry Company submitted bids for the manufacture of the post designed by Mr. Meyers, and also submitted an alternative bid on their type "S" post. Gross Brothers, who were in the foundry business in the

City of Eugene, also submitted a bid for the manufacture of the post designed by Mr. Meyers, and the water board considering the bid of Gross Brothers the best bid, awarded the contract to them December, 1911, for the manufacture of the post designed by Mr. Meyers.

The appellants in this case at the time they filed this suit against the City of Eugene also filed a similar suit against Gross Brothers to enjoin them from manufacturing the posts. The questions involved in the two cases being identical the cases were consolidated.

The contract to Gross Brothers was let before Mr. Grelle applied for a patent on his type "S" post. It is the contention of appellants that the post designed by Mr. Meyers is an infringement upon the patent obtained by Mr. Grelle on the post designed by him, and the appellants ask that the defendants be enjoined from making or selling the post designed by Mr. Meyers, and ask that the defendant City of Eugene be enjoined from using or maintaining said posts, or from furnishing electricity or other lighting agent to light the post erected in the city; and further, that the appellant recover from the City of Eugene the sum of \$250.00 for each and every unlawful act in selling that post infringing upon said patent of Mr. Grelle; and asked further that the city be compelled to account for and pay over all profits which the city has received by reason of its alleged infringement.

The case was tried before Honorable Charles E. Wolverton, Judge, and a decree rendered in favor of appellees and against appellants. The court held

that the post designed by Mr. Meyers did not infringe upon the post designed by Mr. Grelle.

POINTS AND AUTHORITIES.

The design law was intended to encourage the decorative arts, and therefore deals with the appearance rather than the structure, use or functions of the article. The design must be novel and must have called for an exercise of the inventive faculties as distinguished from ordinary mechanical skill. There must be something akin to genius. An effort of the brain as well as of the hand.

30 Cyc, 827 and 849.

Smith v. Whitman Saddle Company, 148 U. S. 674; 37 L. E. 606.

The patent must be of such a character as to have called for an exercise of the inventive or creative faculties of the mind as distinguished from the mere exercise of the knowledge and judgment expected of those skilled in a particular art.

30 Cyc, 828.

Pearce v. Mulford, 102 U. S. 112; 26 L. E. 93.

The design must be novel and must have called for the exercise of the inventive faculties as distinguished from ordinary mechanical skill.

Smith v. Whitman Saddle Company, 148 U. S. 674.

General Gas and Light Co. v. Matchless Mfg. Co., 129 Fed. 137.

Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co., et al., 114 Fed. 362.

Cary Mfg. Co. v. Neal, 98 Fed. 617.

Mere novelty and utility are not enough to sustain a patent, since there must also be invention.

Yale Lock Mfg. Co. v. Greenleaf, 117 U. S. 554; 29 L. E. 952.

Thompson v. Boisselier, 114 U. S. 1.

Glue Company v. Upton, 97 U. S. 3.

Mere mechanical skill is not sufficient but the design must be new and novel and as a result of the inventive genius rather than mechanical skill.

Black Diamond Coal Min. Co. v. Excelsior Coal Co., 156 U. S. 611; 39 L. E. 553.

Knapp v. Morss, 150 U. S. 221; 37 L. E. 1059.

Burt, et al., v. Ivory, et al., 133 U. S. 394.

Hill, et al., v. Wooster, 132 U. S. 693.

The later cases incline toward requiring more inventive skill for design patents than did the earlier ones.

Perry v. Haskins, 111 Fed. 1002.

Crier v. Innes, 160 Fed. 103.

Bolt Company v. Company, 194 Fed. 871.

Mygat v. S. F. Co., 191 Fed. 836.

Palouze Co. v. A. C. Co., 102 Fed. 916.

Phoenix Co. v. Company, 194 Fed. 703.

Phoenix Co. v. Rich, 194 Fed. 708.

The designs should be viewed as wholes, considering their general appearance as they present themselves to the eye of the observer, without special attention to *minutia* of detail or ornamentation.

Hutter v. Broome, 114 Fed. 655.

Byron v. Friedberger, 87 Fed. 559.

Phoenix Co. v. Rich, 194 Fed. 708.

Graff, etc., v. Webster, 189 Fed. 902; 195 Fed. 522.

Gorham v. White, 14 Wall. 511; 20 L. E. 731.

McClain v. Fleming, 96 U. S. 245 (256).

Williams Co. v. N. M. Co., 136 Fed. 210.

West Co. v. Frank, 146 Fed. 388.

F. A. Co. v. Chapin, 151 Fed. 264.

ARGUMENT.

In our opinion there are two vital questions involved in this case:

First: The post designed by Grelle is not subject to patent. The most that can be claimed for it is that it is merely the result of mechanical skill.

Second: That the city's post is not an infringement upon the post designed by Grelle.

This case was decided by the trial court upon the question of infringement, the court holding that the city's post did not infringe Grelle's type "S" post. The evidence shows in this case that before the contract was awarded to Gross Brothers for the manufacture of the city's posts and before Mr. Grelle had applied for letters patent, specifications of the post designed by Meyers and referred to throughout the

case as the city's post, were submitted to the Independent Foundry Company, of which Mr. Grelle is manager and president, for bids, and the Independent Foundry Company submitted a bid for the manufacture of the city's post. The bid was submitted by the Independent Foundry Company through Grelle, and neither Grelle nor the Independent Foundry Company intimated that Mr. Grelle intended to apply for a patent on his design, or that the city's post was an infringement upon the type "S" post, but without a word of protest Grelle and Independent Foundry Company entered into open competition for the manufacture of the city's posts. The bid submitted provides:

"We propose to furnish you ornamental street posts as per your specifications on December 7, 1911, and according to your drawings of your standard ornamental post as follows."

Then follows the price paid, and further the bid provides:

"Also beg to submit alternative quotation on our type "S" post of which you have photograph."

Then follows price on type "S" post. The fact that the Independent Foundry Company, through Grelle, proposed to manufacture the city's posts and openly submitted a bid for the manufacture of said posts and not disclosing to the city that he, Grelle, intended to apply for a patent for his post and without claiming or intimating that the post designed by Mr. Meyers was an infringement on his post, shows bad faith on the part of Grelle. The contract was awarded to Gross Brothers in December, 1911,

and Grelle did not apply for Letters Patent until January, 1912. Grelle's post is not subject to patent for the reason that it is neither new or novel or the result of inventive genius. It is even doing violence to concede that it is the result of mechanical skill, but conceding for the sake of the argument that a type "S" post is the result of mechanical skill, that being so, the post so designed would not be subject to patent.

Wade H. Pipes, architect and witness on behalf of appellees, testified as follows:

"Q. Is there anything novel or new in either one of these lamp-posts in the parts?

A. No, there is not. Similar designs have been made all over the country.

Q. For how long?

A. Well, the top part of this sort of posts has not been in use a great many years. They have been in use since they used to use the old kind of electric lights, that dropped down on a wire. When those went out of date, these began to come in, and they used to twist them up on the pole—an arc light.

Q. Is there anything novel in the fluted column?

A. Well, the fluted Doric column is as old as Greek civilization nearly. I guess it is as old.

Q. You say all these lamp-posts evolve or develop from the column?

A. Yes, they all have the base.

Q. Have you a picture of any architecture—any column there, that would illustrate what you mean?

A. I have a column here that is about 400 years old.

Q. What building is that?

A. Let me see if the name of it is here. Well, it is an English country house, one of the old ones.

Q. How old is it?

A. It is about 400 years old.

Q. Is this from "Country Life"?

A. Yes.

Q. An English publication?

A. Yes."

The testimony of Mr. Pipes will be found on pages 157 and 158, of the transcript of record. Mr. Pipes says the fluted Doric column is as old as Greek civilization and exhibited a cut of a column about 400 years old. It is very difficult indeed to say the number of years that lamp-posts have been in existence, but it is needless to argue that there is anything new or novel concerning the design of a lamp-post. They are as old and ancient as the hills. There is also necessarily a great similarity between all types of light posts, and that being so, the type "S" post is not subject to patent.

In the case of *Hill, et al., v. Wooster, supra*, the court says:

"This court, however, has repeatedly held that under the Constitution and the acts of Congress, a person, to be entitled to a patent, must have invented or discovered some new and useful art, machine, manufacture, or composition of matter, or some new and useful improvement thereof, and that it is not enough that a thing shall be new in the sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must under the Constitution and Statute amount to an invention or a discovery."

In the case of *Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co.*, *supra*, the learned judge says:

“But irrespective of prior patents and other sufficiently proven exhibits, the defense of lack of patentable novelty stands on a broader foundation than the proof produced in court. In design patents the test of identity, on questions of anticipation and infringement, is the eye of the ordinary observer. And in determining this question the court may avail itself of such common knowledge as is possessed by the general public. The fundamental question is whether the inventive faculty has been exercised to produce anything which is original and pleasing to the eye. The eyes of the court cannot be closed to the fact that in the court room itself are electric light fixtures, placed there long before the date of the patent, which show a sphere with a neck and rim so nearly identical with those of the patent that the difference is a mere matter of immaterial proportion. Nor can the andirons of our grandfathers, the door-knob from time immemorial, the old chime bell of the sleigh, the conventional cuspidor, be overlooked. The court must take judicial notice of the oblate spheroid and neck common to the whole field of everyday arts and must hold that this design is merely a double use,—is, at most, the adaptation of an old form to a new purpose. The defense of want of patentable novelty is sustained.”

In the case of *Knapp v. Morss*, *supra*, the court, among other things, says:

“All that he did was to adapt them to the special purpose to which he contemplated their application, by making modifications which did not require invention but only the exercise of ordinary mechanical skill; and his right to a

patent must rest upon the novelty of the means he contrived to carry his idea into practical application."

Grelle's type "S" post is an ordinary five-light post with round base and round column and round arms. Such posts have been in use, no doubt, for a great many years. The city's post is an ordinary five-light post with square base, round column and square arms. Neither post is new or novel or is it the result of any inventive genius and we may add, the designing of these posts require but very little mechanical skill. We are safe in saying that any person possessing ordinary mechanical skill could very easily design different types of light posts.

The evidence shows that the posts are essentially and materially different. The difference can be seen at once from a merely casual observation or comparison between the two posts. The post designed by the city is square at the base with square block panels, and the top and bottom ornamentation of the base is entirely different. The column of the city's post is round and fluted, the head is square with square paneled features in both the head of the post and the arms. The head and arms of the type "S" post are round and fluted. The difference between the two posts is very clearly stated in the opinion of Honorable Charles E. Wolverton, the trial judge, which is as follows:

"The base of the city's post is square in form, with paneling for ornamental appearance. At the top of this is a cap, which is also square, above which rests the column. It has a cap at the top of the column the same as the type 'S' post, but this cap is square in form. The shoulder

or head is also square, and the cap above that is square. The arms are also square, with panel ornamentation, and the curves at the outer extremities drop a little more abruptly than those of the type 'S' pattern."

Y. D. Hensill, a witness for the appellees, in describing the difference between the two posts testified as follows:

"The type 'S' post has a round base, with more moldings than the city's post. The type 'S' post has a fluted base. The city's post is square, with a square sunk panel. The type 'S' post is more ornate at the base of the shaft than the city's post. Both posts have fluted columns. Type 'S' post has a round cap or head. The city's post has a square, with sunk panels. The type 'S' post is ornamental. There is a difference in the shape of the arms. One is round—the type 'S' post is round, increasing to elliptical, while the city post, the city arms are square, with a square panel, or with a sunk panel shaped similar to the outline of the arm."

(The particular testimony of the witness referred to will be found at page 86, of the transcript of record.)

Wade H. Pipes, witness on behalf of the appellees, also clearly defined the difference between the two posts. Mr. Pipes says:

"The city's post is a much coarser motive altogether. This (meaning the type 'S' post) is more refined. Of course, all of these posts are based on a column. The column has been in use for hundreds of years. But these posts are about as dissimilar as lamp posts could be. Of course, all cities, both in America and Europe, have agreed pretty much about what a post

ought to be in its general form. There is not very much chance for originality in that line at all. The only chance for originality the designer has in designing a post is in the detail."

And the witness testifying further says:

"Q. Well, now, would those posts be likely—would the difference be noted by a casual observer, in those posts, in your opinion?

A. Well, I should think it would.

Q. Have you examined the top of the type 'S' post and the city's post here in the court room?

A. Yes.

Q. Would a purchaser be likely to be deceived by the city's post?

A. That would be impossible.

Q. Would you say that one was a copy of the other in any way?

A. I cannot see how it would be.

Q. Is there anything novel or new in either one of these lamp-posts in the parts?

A. No, there is not. Similar designs have been made all over the country.

Q. For how long?

A. Well, the top part of this sort of posts has not been in use a great many years. They have been in use since they used to use the old kind of electric lights, that dropped down on a wire. When those went out of date, these began to come in, and they used to twist them up on the pole—an arc light.

Q. Is there anything novel in the fluted column?

A. Well the fluted Doric column is as old as Greek civilization nearly. I guess it is as old.

Q. You say all these lamp-posts evolute or develop from the column?

A. Yes. That all have the base.

Q. Have you a picture of any architecture—any column there, that would illustrate what you mean?

A. I have a column here that is about 400 years old.”

And the witness further testifying says:

“The general impression is the same, but to any designer, although those mouldings seem just very similar there on a small scale drawing like this is, if you draw that the full size, you would see a very great deal more difference than that.”

The test is, are the designs substantially the same?

Would the ordinary observer giving the attention a purchaser usually gives, purchase one supposing it to be the other? The leading case upon this question is the case of *Gorham v. White*, 14 Wall. 511.

In this case the court holds (Page 528):

“We hold, therefore, that if, to the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”

The appellant introduced in evidence comparative drafts of the outline of the two posts. But, as the court holds, this cannot be a safe test. It is the constructed post as it appears to the eye of the ordi-

nary or casual observer, and when so viewed the two posts are readily distinguishable.

We are safe in saying that the evidence shows conclusively that the constructed posts are essentially different, and in addition to the testimony of the witnesses the posts were brought into the court room and exhibited at the trial of this case, and the court from a comparison could readily see that the posts were essentially different.

We respectfully submit that under the evidence the decree rendered in the District Court should be affirmed.

Respectfully submitted

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Solicitors for Appellees.

